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10/665,222	09/17/2003	Matt Nordstrom	05127.00228	6277

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BANNER & WITCOFF, LTD.  
TEN SOUTH WACKER DRIVE  
SUITE 3000  
CHICAGO, IL 60606

EXAMINER
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OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

MAIL DATE	DELIVERY MODE
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09/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/665,222	NORDSTROM, MATT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark A. Osele	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-12, 14-20 and 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-12, 14-20, 22-37 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 38 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 7-8, 10-11, 24, 25, 29, 33 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Kisha et al. (P.G. Pub. 2003/0054137). Kisha et al. teaches a method of joining a plurality of textile elements to make an article comprising the steps of: providing a first bond between a third textile element, 322, and an adhesive element, 326; forming a second bond between a second textile element, 324, and the adhesive element by applying heat and pressure (paragraph 0047); and attaching the joined second and third textile elements to a first textile element (paragraph 0043), wherein the second and third textile elements have substantially similar dimensions (Figs. 9A and 10) and the first textile element has an area greater than either the first or second textile elements.

Application/Control Number: 10/665,222

Page 3

Art Unit: 1734

Regarding claim 7, the third textile element, 322, has an aperture therein (Figure 10).

Regarding claim 8, the second and third textile elements are attached to the first textile element by adhesive bonding (paragraph 0043).

Regarding claim 24, Kisha et al. shows an article comprising a first textile element, 322, a second textile element, 324, extending over the first textile element and bonded only at the outer perimeter to the first textile element (See Fig. 10), and a third textile element extending over the second textile element and bonded to the second textile element through the use of an adhesive element, 328 (paragraph 0043).

Regarding claim 25, the second textile element is bonded to the first textile element using adhesive, 326.

Regarding claim 29, the third textile element is an article of apparel (paragraph 0043).

Regarding claim 33, Kisha et al. teaches that the appliqué can have a third layer, which would have the same outer perimeter of the second textile element (paragraph 0048).

3. Claims 16-19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Stahl (5,422,173). Stahl '173 teaches a method of joining a plurality of textile elements to make an article comprising the steps of: providing a first bond between a second textile element, 26, and an adhesive element, 24; forming a second bond between a first textile element, 22, and the adhesive element by applying heat and

pressure between platens (column 3, lines 57-63); and attaching the joined second and first textile elements to an article of clothing (column 5, lines 11-24), wherein the first textile element and the adhesive element have substantially similar outer perimeters, the second textile element has a greater outer perimeter than either the first textile element or the adhesive element, and the bond between the second textile elements and the adhesive element is in a spaced relationship with the outer edges of the second textile element (Fig. 2).

Regarding claims 17-18 the adhesive element is a thermoplastic polymer such as urethane or polyester (column 3, lines 18-19).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 7, 9-12, 14, 24-27, 29, 32, 34-35, 37, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freno et al. (4,591,521) in view of Cahill (5,123,870). Freno et al. shows the method of using fabric to make a three dimensional facial design (Fig. 3) on a garment 13, (Fig. 1). Cahill shows the method of making a three dimensional facial design from fabric comprising the steps of: providing a first bond between a third textile element, 212, and an adhesive element, 270; forming a

second bond between a second textile element, 210, and the adhesive element by applying heat and pressure (column 5, lines 46-51); wherein the second and third textile elements have substantially similar dimensions (Fig. 21) and the first textile element has an area greater than either the first or second textile elements. It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the three dimensional design of Cahill to a garment because Freno et al. shows the desire to have three dimensional designs on garments, but the process of Freno et al. would result in the bottom hem of the garment being uneven as in some places fabric would be pulled outward and upward by the stuffing material, 17, 18, 19, while applying the design of Cahill to the garment of Freno et al. would not cause the same unevenness.

Regarding article claims 24 and 34, Cahill shows the first and second textile elements bonded (or in the case of claim 34, the second and third elements) at the outer perimeter with internal areas, 274, 289, 282, 286, 278 not bonded (See Fig. 20). Although Cahill does not show the textile elements bonded at the outer perimeter, the claimed arrangement would have been a design choice for one of ordinary skill in the art, such as when a three dimensional apple or football is desired as the design.

Regarding claims 4 and 12, although Cahill teaches using a heated iron to apply the bonding heat and pressure, It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the platen of a heated press because Cahill teaches that any suitable apparatus can be used (column 5, lines 48-49), and heated press platens are known alternatives to heated irons.

Regarding claim 7, the third textile element, 210, of Cahill has an aperture therein for stuffing soft material into the cavities (column 8, lines 14-17).

Regarding claims 9, 26, Cahill shows the joined second and third textile elements can be attached to an additional textile element by sewing (column 9, lines 7-14).

Regarding claims 14, 27, and 35, the adhesive of Cahill is a thermoplastic polymer (column 7, line 55).

6. Claims 4, 12, 14, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kisha et al. (P.G. Pub. 2003/0054137) in view of Stahl (5,422,173). As shown in paragraph 2 above, Kisha et al. shows all of the claimed limitations except for heated platens and the particular claimed adhesive. Stahl also shows the method of making an appliqué for a garment wherein the layers are bonded together using a thermoplastic polymer material (column 3, lines 16-20) which creates the bond using heat and pressure from the platen of a heated press (column 3, lines 57-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the bonding adhesive and pressing means of Stahl in the method of Kisha et al. because Stahl shows that the platen of a heated press can provide the necessary heat and pressure Kisha et al. requires for bonding. Furthermore, Kisha et al. teaches that any suitable heat and pressure adhesive can be used (paragraph 0043) and Stahl shows that a thermoplastic polymer material is a conventional adhesive used in making appliqués.

Regarding claim 28, Stahl shows the adhesive element to be a thermoplastic polymer such as urethane (column 3, lines 18-19).

7. Claims 8 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freno et al. (4,591,521) in view of Cahill (5,123,870) as applied to claim 1 above, and further in view of Stahl (5,422,173). The references as combined fail to show attaching the joined second and third textile elements to the first textile element by bonding. Stahl also shows adhesive bonding two layers of an appliqué to each other followed by attaching the appliqué to a garment wherein the attaching is accomplished by adhesive bonding. It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the appliqué of the references as combined to the garment by adhesive bonding because Stahl teaches that adhesive bonding of an appliqué to a garment is functionally equivalent to sewing the appliqué to the garment.

Regarding claim 36, Stahl shows the adhesive element for bonding layers of an appliqué to be a thermoplastic polymer such as urethane (column 3, lines 18-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the adhesive of Stahl in the article of the references as combined because this is shown to be an effective polymer for bonding layers of an appliqué.

8. Claims 15, 30, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kisha et al. (P.G. Pub. 2003/0054137) in view of Mahn, Sr. et al. (4,971,644). As shown in paragraph 2 above, Kisha et al. shows all of the claimed



Art Unit: 1734

limitations except for the textile element and garment to be made of a mesh material. Mahn, Sr. et al. teaches that sports jerseys are commonly made from a mesh material and it is desirable to have a number applied to the jersey. Furthermore, Mahn, Sr. et al. teaches that numbers that cover the holes in a mesh jersey are aesthetically unappealing and block air flow (column 1, lines 48-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the garment and the textile element of Kisha et al. of a mesh material because Mahn, Sr. et al. teaches that mesh garments and applied emblems are desirable for sport uniforms.

Regarding claim 32, the second textile element is shaped to form a functional design.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (5,422,173) in view of Mahn, Sr. et al. (4,971,644). As shown in paragraph 3 above, Stahl shows all of the claimed limitations except for the textile element and garment to be made of a mesh material. Mahn, Sr. et al. teaches that sports jerseys are commonly made from a mesh material and it is desirable to have a number applied to the jersey. Furthermore, Mahn, Sr. et al. teaches that numbers that cover the holes in a mesh jersey are aesthetically unappealing and block air flow (column 1, lines 48-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the garment and the textile element of Stahl of a mesh material because Mahn, Sr. et al. teaches that mesh garments and applied emblems are desirable for sport uniforms.

Application/Control Number: 10/665,222  
Art Unit: 1734

Page 9

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl in view of either Conrad (3,662,878) or Castro, Jr. (5,906,006). As shown in paragraph 3 above, Stahl shows all of the claimed limitations except for the textile element to be sewn on a garment. Conrad (column 1, lines 23-26) and Castro, Jr. (column 2, lines 31-38) each teach that adhesive bonding or sewing are known for putting a textile element on a garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sew the textile element of Stahl on a garment because Conrad and Castro, Jr. each teach this to be a conventional alternative to adhesive bonding.

***Allowable Subject Matter***

11. Claims 38-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: There would be no motivation to make the combination of Cahill and Freno et al. of mesh material because the internal stuffing would block the holes of the mesh material.

Application/Control Number: 10/665,222  
Art Unit: 1734

Page 10

***Response to Arguments***

13. Applicant's arguments with respect to claims 1-4, 7-12, 14-15, and 24-42 have been considered but are moot in view of the new ground(s) of rejection.

14. Applicant's arguments filed July 5, 2007 have been fully considered but they are not persuasive. Regarding claim 16, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Application/Control Number: 10/665,222

Page 11

Art Unit: 1734

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**MARK A. OSELE**  
**PRIMARY EXAMINER**

September 17, 2007